

REMARKS

Claims 1 - 19 are pending the application; Claims 1 - 19 stand rejected. By this Amendment, Claim 19 has been amended. These amendments add no new matter to the application.

Claim 19 stand rejected under 35 USC 112 as allegedly indefinite; Applicant respectfully traverses this rejection. Applicant submits that the phrase, "and the like" has been commonly used in claim practice for decades to provide access to equivalencies. However, in the interest of arriving at an early definition of allowable subject matter, Claim 19 has been amended to omit the phrase, and is therefore now believed to be in condition for allowance.

Claims 2 and 8-18 again stand rejected under 35 USC 102e over Ziff; Applicant again respectfully traverses this rejection. The Ziff reference that issued as US Patent 6,557,013 was filed on March 15, 2000, several months after the effective priority for Applicant's present application. Applicant therefore reasserts that Ziff is not properly available under section 102e as a reference in this case, and should accordingly be withdrawn as a cited reference. Applicant filed the substance of this present 111a application as provisional application 60/165,140 on November 12, 1999 and that substance, at least as currently claimed, was not significantly altered upon the 111a filing on November 10, 2000. The substance of the support for the current claims was therefore on file in the US PTO several months before the only proper section 102e filing date that can be accorded to the Ziff reference.

The Examiner now cites Ziff's provisional that was filed 3/24/99 as the appropriate 102e reference. But section 102e states (in pertinent part), "A person shall be entitled to a patent unless ... (e) the invention was described in (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent (emphasis

added)” Applicant respectfully submits that a provisional patent cannot be a 102e reference. A provisional is not published and therefore not available to the public as a reference, and it is not possible for an patent to be “granted” on a provisional. Section 102e requires that a 102e reference have been granted on the application filed as the putative 102e reference. In this case, the cited Ziff provisional never was granted as a patent, and the earlier cited Ziff ‘013 patent was not filed early enough to be a usable 102e reference. In addition, we have no idea what, if anything, was described in Ziff’s provisional, and the Examiner has not alleged that the provisional and the ‘013 patent are in any way identical. Indeed, it is quite typical that provisional applications are mere shell versions of the 111a applications the subsequently support. There is therefore no support for the 102e requirement that the invention as claimed be “described” in the cited reference. For all we know, the pertinent descriptions in Ziff ‘013 (which Applicant does not here admit are read on by any of the claims) were not present in the provisional application, even if it were possible under section 102e to read back to the provisional filing date.

Claims 2 and 8 and all claims dependent thereon are therefore believed to be in condition for allowance, and reconsideration and allowance are requested.

Claims 1, 3-7 again stand rejected under 35 USC 103 over Asplen; Applicant again respectfully traverses these rejections. Claims 1 and 3-7 all explicitly require:

A system for automatically summarizing company innovations;
that uses intelligent agents to automatically perform searches on the Internet;
that the searches find competing or encroaching ideas;
and that the system generate reports which list potential competitive strengths or weaknesses.

The Examiner now cites Asplen column 3, lines 1-27 and column 2, lines 9-14 and from these lines fabricates an impermissible hindsight reconstruction of the limitations of Claim 1 referred to above. Applicant has now reviewed the additional cited lines 1-9 and find no information there that differs from or adds to what is contained in previously cited lines 10-27. Moreover, the Examiner stretches the wording of the Asplen disclosure beyond reasonable limits to support a reading that the above referred to limitations of Claim 1 somehow read on the Asplen disclosure.

The undersigned has again diligently reviewed the cited reference, and in the cited columns and finds no discussion at all of any of certain of the limitations of Claim 1, as more particularly elucidated below.

Limitation: "A system for automatically summarizing company innovations"

Asplen is a reference directed strictly to a product planning system, not an innovation system. It offers no discussion of innovation, innovations, or the need for summarizing company innovations. It only speaks of products, and does not teach any level of required innovation for any such products, or even that any "products" require, or would benefit from, any level of innovation at all, and there are no discussions of summarization. It certainly does not discuss or suggest any automatic summarization. Asplen actually teaches away from all of this by explicitly referring to product development, and especially product development from the point of view of economic feasibility, not innovative merit. Asplen further teaches away from automatic evaluation by expressly disclosing manual, human evaluation. Asplen really only talks about, "the product is evaluated according to predetermined criteria". Col.3, lines 16-17.

Limitation: “uses intelligent agents to automatically perform searches on the Internet”

Asplen does not discuss or suggest use of intelligent agents to perform, and automatically perform at that, searches on the Internet, or any kind of searches at all, for that matter. Asplen specifically teaches that any evaluation (of ‘products’, not innovations) must be done manually by a human evaluator, not an ‘agent’ as defined by the specification, and certainly not ‘automatically’. The Examiner’s argument here that the passing reference to, “telecommunication lines for internet” (col.2 line 13), is actually a suggestion that searches, automatic searches, and automatic searches by intelligent agent, all be done on the internet, is just not supported by a fair reading of the teachings of Asplen. The cited line simply does not suggest anything about searches, intelligent agents or automatic searching, and is therefore not a proper 103 reference. It is a hindsight combination only.

Limitation: “the searches find competing or encroaching ideas”

Asplen contains no discussion at all of searches anywhere that find competing or encroaching ideas. Asplen’s one reference to an evaluation criteria, namely “whether it will be competitive” (col.3 lines 14-15), is no suggestion at all of searching anywhere to find any competing or encroaching ideas.

Limitation: “generate reports which list potential competitive strengths or weaknesses”

Asplen does not teach generation of reports which list potential competitive strengths or weaknesses. Asplen does not teach generation of reports at all as defined in the specification, but only certain manually customized letters to submitters, and then only as to the status of their submission. Asplen does not teach listing potential competitive strengths or weaknesses, either in such letters or anywhere else.

The Examiner refers at page 8 of her action letter to various disclosures that “correspond to the claimed limitations.” Applicant respectfully submits that ‘correspondence’ is not a valid criterion for evaluation novelty or non-obviousness under the patent statute. A claim is anticipated or rendered obvious only if every one of its limitations reads directly upon teachings of a reference (102) or reads upon what may be supposed to be the knowledge of a person of ordinary skill in the art, as elucidated by a particular combination of references. Applicant respectfully submits that the idea that two ideas might correspond is too vague to support a rejection.

Claims 1 and 3-7 are therefore believed not to be anticipated by or rendered obvious by any of the cited references and are believed to be in condition for allowance; reconsideration and allowance are requested.

Applicant believes that it has responded fully to all of the concerns expressed by the Examiner in the Final Action, and respectfully requests that early favorable action be taken on all claims pending in the application. If the Examiner has any further concerns, Applicant requests a call to Patrick Dwyer at (206) 550-4049.

Respectfully submitted,



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